

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed August 12, 2003

Lawrence Music, Inc.

v.

Samick Music Corporation

Peter Cataldo, Interlocutory Attorney

This case now comes before the Board for consideration of (1) opposer's motion for extension of time in which to file a notice of opposition; and (2) opposer's motion to suspend proceedings herein pending the outcome of a civil action involving the parties to the instant opposition.¹ The motions are fully briefed.²

The Board has carefully considered the arguments of both parties with regard to the above motions. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of this matter.

¹ Civil Action No. 01-1029, styled *Lawrence Music, Inc. v. Samick Music Corporation*, filed on June 6, 2001 in the United States District Court for the Western District of Pennsylvania.

² In addition, opposer has submitted a combined reply brief in support of its motions which the Board has entertained. Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a).

Motion to Extend Time to Oppose

The Board turns first to opposer's motion to extend its time to file a notice of opposition.

In its motion, opposer argues that extraordinary circumstances, in the form of its pending civil action against applicant, warrant an "indefinite extension of time to oppose" registration of applicant's application Serial No. 76/342,386. It is noted, however, that opposer filed its motion to extend along with the notice of opposition upon which the instant opposition proceeding is predicated. Inasmuch as the Board has instituted the instant opposition proceeding concerning opposer's opposition to the registration of applicant's application Serial No. 76/342,386, opposer's motion to further extend its time in which to submit its notice of opposition is moot and will be given no further consideration.

Motion To Suspend

The Board next to opposer's motion to suspend the instant opposition proceeding pending the disposition of the above referenced civil action brought by opposer against applicant in the United States District Court for the Western District of Pennsylvania.

In that regard, whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings may be suspended

until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colitis Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971). USPQ 861 (TTAB 1973).

In this case, the parties to Civil Action 01-1029 and the instant opposition proceeding are the same. Further, the mark at issue in this proceeding, namely, "SAMICK", is contained in the internet domain name, "SAMICKGUITARS.COM", at issue in the civil action. The allegations in plaintiff's (opposer herein) complaint include a declaration on non-infringement under Sections 37 and 43(a) of the Lanham Act regarding the trademark underlying the above domain name. Further, the relief sought by plaintiff in the civil action includes an order declaring that plaintiff has and shall have the exclusive and continued right to continue to use the domain name, "SAMICKGUITARS.COM". Any determination of opposer's infringement of or applicant's rights to the "SAMICK" mark underlying the domain name, "SAMICKGUITARS.COM" in the civil action will have a bearing on the issues before the Board. Moreover, to the extent

that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986).

In view of the foregoing, and in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, **proceedings herein are suspended** pending final disposition of Civil Action 01-1029.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.